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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,942	12/08/2003	Jia-Ning Xiang	8981.0003	9013

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EXAMINER

DENTZ, BERNARD I

ART UNIT PAPER NUMBER

1625

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/728,942

Applicant(s)

XIANG ET AL.

Examiner

Bernard Dentz

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-136 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-136 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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The below Groups I-VI include the pharmaceutical compositions having the corresponding compound as active ingredient.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4,6-47,81-83 and 118, drawn to compounds where R1 is H and X is OR1, classified in class 562, subclass 439.
- II. Claims 1-3,5-47 and 118, drawn to compounds where X is OR10 and R1 is formula IX, classified in class 560, subclass 24.
- III. Claims 1,48,49,51,54-69,74-80,84-92,96-101 and 113-118, drawn to compounds where X is of the formula II and R1 is H, classified in class 562, subclass 34.
- IV. Claims 1,48,49,52,54-69,74-80,96-101 and 113-118, drawn to compounds where X is formula II and R1 is formula IX, classified in class 560, subclass 24.
- V. Claims 1,48-52,54-73, and 93-118, drawn to Compounds where X is formula III and R1 is H, classified in class 560, subclass 34.
- VI. Claims 1,48-51,53-73, and 93-118, drawn to compounds where X is formula III and R1 is IX, classified in class 560, subclass 24.
- VII.-XII. Claims 119-126 drawn to pharmaceutical compositions containing a compound of the respective above Group and at least 1 additional active agent.

After a compound has been found allowable a single method of use will be examined.

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The above Groups are subject to restriction because there is a wide variety of structure in X and R1. Carboxylic acids, simple esters and complex esters with further ester and amide containing groups in the alcohol portion thereof are present. Also when R1 is H a simple hydrazine moiety is present but also R1 can be complex group IX.

Obviously the 2 sets of pharmaceutical compositions in all probability, and in fact as can be seen from the disclosure, have different utilities.

Thus restriction is proper.

Further in case no generic claim is found allowable election of a single supported species is now required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard Dentz whose telephone number is 571-272-0683. The examiner can normally be reached on Mon-Fri from 8 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dentz
8-10-2005

B Dentz
STANDARD DENTZ GROUP 1233
PATENT EXAMINER
10/16/05